

### REMARKS/ARGUMENTS

Claims 26 and 27 are pending. Claims 1-25 and 28 are canceled without prejudice to their presentation in another application.

Claims 26 and 27 stand rejected under 35 U.S.C. § 102(a) as allegedly anticipated by PCT Patent Application No. WO 98/49348 ("the Dean application"). Applicants request reconsideration of this rejection because the disclosure of the Dean application is too broad to be anticipatory. The Dean application discloses certain modified oligonucleotides which are formulated according to methods known in the art (see, for example, page 3, lines 7-15 and page 4, lines 18-19). Such formulations may include many possible ingredients as detailed on page 19, line 5 to page 23, line 14 of the Dean application. Because the compositions recited in the instant claims are not explicitly identified in the Dean application, Applicants surmise that the instant rejection has been entered because the Office is of the view that one skilled in the art could have produced a claimed invention by picking and choosing from among the many possibilities discussed above. However, the need for such picking and choosing is plainly inconsistent with a finding of anticipation. *Id.*, 172 U.S.P.Q. at 526; *In re Schaumann*, 572 F.2d 312, 314 (C.C.P.A. 1978) ("By having to select [a variable] from among the many possibilities which R in the structural formula [of the reference] may be, . . . does not give rise to the claimed compound being fully anticipated by the reference."). Given the many possible compositions detailed in the Dean application's disclosure, the rejection for alleged anticipation is improper and should be withdrawn.

Claims 26 and 27 stand rejected under 35 U.S.C. § 102(a) as allegedly anticipated by PCT Patent Application No. WO 97/25339 ("the Lockett application"). Applicants traverse the rejection. As with the rejection based on the Dean application, the rejection based on the Lockett application is based on picking and choosing among the possible compositions disclosed in the Lockett application (see, for example, page 2, line 5 to page 3, line 11 and page 8, line 20 to page 13, line 23). Because such picking and choosing is inconsistent with anticipation, Applicants respectfully request reconsideration and withdrawal of the rejection.

Furthermore, the Lockett application teaches introducing its compositions into a cell by exposing the cell to the compositions. It does not discuss administration across the

**DOCKET NO.:** ISIS-4947

**Application No.:** 10/071,822

**Office Action Dated:** January 30, 2004

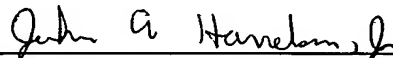
**PATENT**

mucosal membrane. As the Lockett application does not teach every element of the instant claims, Applicants respectfully request reconsideration and withdrawal of the rejection.

Applicant believes that the foregoing is a full and complete response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejections and allowance of all of pending claims 26 and 27 is respectfully requested.

Respectfully submitted,

Date: April 29, 2004

  
\_\_\_\_\_  
John A. Harrelson, Jr.  
Registration No. 42,637

Woodcock Washburn LLP  
One Liberty Place - 46th Floor  
Philadelphia PA 19103  
Telephone: (215) 568-3100  
Facsimile: (215) 568-3439